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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/771,907  | 02/03/2004  | Cyril A. Migdal      | 0206-PA             | 3867             |
| 7590  | 08/18/2006  |                      | EXAMINER            |                  |
| CROMPTON CORPORATION<br>Benson Road<br>Middlebury, CT 06749 |             |                      | LANG, AMY T         |                  |
|   |             |                      | ART UNIT            | PAPER NUMBER     |
|   |             |                      | 1714                |                  |

DATE MAILED: 08/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                        |                     |  |
|------------------------------|------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|                              | 10/771,907             | MIGDAL ET AL.       |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                              | Amy T. Lang            | 1714                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-20 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_ is/are allowed.
- 6) Claim(s) 1-20 is/are rejected.
- 7) Claim(s) \_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. ____ .   |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <del>2005</del> Amy 24, 2005 | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: ____ .                                   |

## DETAILED ACTION

### ***Double Patenting***

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Three (3) obviousness-type double patenting rejections are set forth below.

### ***Double Patenting, I***

2. Claims 1 and 11 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 3 of copending Application No. 10/892610 (published as 2005/0176594 A1). Although the conflicting claims are not identical, they are not patentably distinct from each other because of the reasons given below.

Claim 1 of US appl. '610 discloses a lubricant composition. Claim 2 discloses an antioxidant additive in the composition.

Applicants' attention is drawn to MPEP 804 where it is disclosed that "the specification can always be used as a dictionary to learn the meaning of a term in a patent claim." *In re Boylan*, 392 F.2d 1017, 157 USPQ 370 (CCPA 1968). Further, those portions of the specification which provide support for the patent claims may also be examined and considered when addressing the issue of whether a claim in an application defines an obvious variation of an invention claimed in the patent. (underlining added by examiner for emphasis) *In re Vogel*, 422 F.2d 438, 164 USPQ 619,622 (CCPA 1970).

Consistent with the above underlined portion of the MPEP citation, attention is drawn to where US '610 discloses the antioxidants as hindered phenolics and hydroxylated thiadiphenyl ethers, which overlaps with the instantly claimed thioethers ([0090]). Therefore, a mixture of the two disclosed antioxidants would have been obvious. The additive mixture comprising the two antioxidants would intrinsically increase the oxidation stability of the lubricant composition.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

3. Claims 1 and 11 are directed to an invention not patentably distinct from claims 1 and 3 of commonly assigned copending Application No. 10/892610 (published as 2005/0176594 A1). Specifically, see the discussion set forth in paragraph 2 above.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300). Commonly assigned assignee, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

*Double Patenting, II*

4. Claims 1 and 11 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 12-14 of copending Application No. 10/483342 (published as 2004/0147414 A1). Although the conflicting claims are not identical, they are not patentably distinct from each other because of the reasons given below.

Claims 1, 12, and 13 of US appl. '342 disclose a lubricating composition. Claim 14 discloses an antioxidant additive in the composition.

Applicants' attention is drawn to MPEP 804 where it is disclosed that "the specification can always be used as a dictionary to learn the meaning of a term in a patent claim." *In re Boylan*, 392 F.2d 1017, 157 USPQ 370 (CCPA 1968). Further, those portions of the specification which provide support for the patent claims may also be examined and considered when addressing the issue of whether a claim in an application defines an obvious variation of an invention claimed in the patent. (underlining added by examiner for emphasis) *In re Vogel*, 422 F.2d 438, 164 USPQ 619,622 (CCPA 1970).

Consistent with the above underlined portion of the MPEP citation, attention is drawn to where US appl. '342 discloses the antioxidant as hindered phenolics and hydroxylated thiodiphenyl ethers, which overlaps with the instantly claimed thioethers ([0072]). Therefore, a mixture of the two disclosed antioxidants would have been obvious. The additive mixture comprising the two antioxidants would intrinsically increase the oxidation stability of the lubricant composition.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

5. Claims 1and 11 are directed to an invention not patentably distinct from claims 1 and 12-14 of commonly assigned copending Application No. 10/483342 (published as 2004/0147414 A1). Specifically, see the discussion set forth in paragraph 4 above.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300). Commonly assigned assignee, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

*Double Patenting, III*

6. Claims 1 and 11 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 3 of U.S. Patent No. 6,887,835 B1 (Migdal). Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following explanation.

Claim 1 of US '835 discloses a lubricant composition. Claim 3 discloses an antioxidant additive in the composition.

Applicants' attention is drawn to MPEP 804 where it is disclosed that "the specification can always be used as a dictionary to learn the meaning of a term in a patent claim." *In re Boylan*, 392 F.2d 1017, 157 USPQ 370 (CCPA 1968). Further, those portions of the specification which provide support for the patent claims may also be examined and considered when addressing the issue of whether a claim in an application defines an obvious variation of an invention claimed in the patent. (underlining added by examiner for emphasis) *In re Vogel*, 422 F.2d 438,164 USPQ 619,622 (CCPA 1970).

Consistent with the above underlined portion of the MPEP citation, attention is drawn to where US '835 discloses the antioxidant as hindered phenolics and hydroxylated thiadiphenyl ethers, which overlaps with the instantly claimed thioethers (column 7, lines 49-55). Therefore, a mixture of the two disclosed antioxidants would have been obvious. The additive mixture comprising the two antioxidants would intrinsically increase the oxidation stability of the lubricant composition.

7. Claims 1 and 11 are directed to an invention not patentably distinct from claims 1 and 3 of commonly assigned US 6,887,835 (Migdal). Specifically, although the copending claims are not identical, they are not patentably distinct for the reasons set forth in paragraph 7 above.

8. The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP

Chapter 2300). Commonly assigned US 6,887,835 B1, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

### ***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1, 2, 4, 6-8, 11, 12, 14, and 16-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Reyes-Gavilan (EP 1,054,052 A2).

Reyes-Gavilan discloses a lubricating composition comprised of lubricating oil and antioxidants ([0001]). The antioxidants encompass a hindered phenolic and a

thioether compound ([0008], [0047]). The hindered phenols are further disclosed as 2,6-di-tert-butyl-4-methylphenol, 2,6-di-tert-butyl-4-ethylphenol, and 2,6-di-tert-butyl-4-n-butylphenol ([0014], [0015]). The thioether antioxidant is further disclosed with the formula ( $C_{13}H_{27}OCCH_2CH_2)_2S$ , which clearly overlaps the instantly claimed structure in claims 4 and 14 ([0047]). The amount of the hindered phenolic antioxidant is disclosed as 25 to 60 wt% of the lubricating composition, while the amount of the thioether antioxidant is 5 to 30 wt% ([0047], [0062]). Therefore, if the hindered phenolic is present at 60 wt% and the thioether at 30 wt%, the ratio of hindered phenolic to thioether is 2:1, which clearly overlaps the instant range of 70:30 to 30:70.

Reyes-Gavilan discloses the specified combination of the additives in the lubricant, which includes the hindered phenolic antioxidant and thioether antioxidant, as producing superior performance characteristics including oxidation stability ([0048]). Therefore, when two disclosed antioxidants are combined in a lubricant, a method of stabilizing the oxidation process is produced.

Other additives are also included in the lubricant composition including viscosity index improvers, pour point depressants, dispersant, detergents, rust inhibitors, antiwear agents, metal deactivators, and other antioxidants ([0052] – [0060]).

Therefore, Reyes-Gavilan '052 anticipates the cited present claims.

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

13. Claims 1 and 11 are rejected under 35 U.S.C. 103(a) as being obvious over Grabowski (US 2005/0176594 A1 corresponding to copending Application No. 10/892610).

The applied reference has a common assignee with the instant application.

Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer

in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(l)(1) and § 706.02(l)(2).

For explanation of the rejection, see paragraph 2 above.

14. Claims 1 and 11 are rejected under 35 U.S.C. 103(a) as being obvious over Migdal (US 2005/0147414 A1 corresponding to copending Application No. 10/483342).

The applied reference has a common assignee with the instant application.

Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(l)(1) and § 706.02(l)(2).

For explanation of the rejection, see paragraph 4 above.

15. Claims rejected under 35 U.S.C. 103(a) as being obvious over Migdal (US 6,887,835 B1).

The applied reference has a common assignee with the instant application.

Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(l)(1) and § 706.02(l)(2).

For explanation of the rejection, see paragraph 6 above.

16. Claims 5 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reyes-Gavilan (EP 1,054,052 A2) in view of Oysaed (US 2006/0122295 A1).

Reyes-Gavilan, as discussed in paragraph 10 and incorporated here by reference, discloses a lubricating composition comprised of a hindered phenolic

antioxidant and a thioether ether antioxidant. The combination of the two antioxidants is disclosed as an advantageous stabilizer to the lubricant composition ([0047]). Although Reyes-Gavilan discloses a specific thioether as a dialkyldithiopropionate, it is also disclosed that other thioethers are equally advantageous ([0047]).

Reyes-Gavilan does not specifically disclose the thioether as a ditridecyldithiopropionate.

Oysaed also discloses a composition that utilizes the combination of hindered phenolic antioxidants and thioether antioxidants to stabilize oxidation ([0005], [0006], [0020]). These antioxidants have traditionally and are still currently being used for this purpose ([0005]). The hindered phenolic antioxidant is further disclosed as 2,6-di-tert-butyl-4-methylphenol, which clearly overlaps the instantly claimed antioxidant and the hindered phenolic antioxidant disclosed by Reyes-Gavilan. The thioether antioxidant is further disclosed as di-tridecyl-thio-di-propionate, which is identical to the instantly claimed ditridecyldithiopropionate ([0018]). This specific combination of antioxidants provides advantageous characteristics including low volatility, high melting point, hydrolytic and thermal stability, and the absence of unwanted side effects.

Reyes-Gavilan discloses the combination of a hindered phenolic antioxidant and thioether antioxidant, where any thioether can be utilized. Oysaed utilizes the same combination, but with a specific thioether antioxidant to produce advantageous characteristics of the lubricating composition. It therefore would have been obvious for Reyes-Gavilan to also utilize the specific thioether antioxidant disclosed by Oysaed for the advantageous results.

17. Claims 3 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reyes-Gavilan (EP 1,054,052 A2) in view of Wegmann (WO 2005/023886).

Reyes-Gavilan, as discussed in paragraph 10 and incorporated here by reference, discloses a lubricating composition comprised of a hindered phenolic antioxidant and a thioether antioxidant. The combination of the two antioxidants is disclosed as an advantageous stabilizer to the lubricant composition ([0047]). Although Reyes-Gavilan discloses a specific hindered phenolic as 2,6-di-tert-butyl-4-ethylphenol, it is disclosed that other hindered phenolics can be utilized in the composition ([0047]).

Reyes-Gavilan does not specifically disclose the hindered phenolic as butyl-3-(3,5-di-tert-butyl-4-hydroxyphenol)propionate.

Wegmann also discloses a composition that utilizes the combination of hindered phenolic antioxidants and thioether antioxidants to stabilize oxidation (page 1, lines 3-8; page 2; page 2, lines 10-12). The hindered phenolic antioxidant is further disclosed as an ester of (3,5-di-tert-butyl-4-hydroxyphenyl)propionic acid with a mono alcohol, such as methanol, ethanol, or octanol (page 7, lines 7-12). Since Wegmann discloses the mono alcohol as having either 1, 2, or 8 -OH groups, it would have been obvious for Wegmann to use butyl, since 4 -OH groups falls between 2 and 8. Therefore, the scope of Wegmann discloses a butyl-3-(3,5-di-tert-butyl-4-hydroxyphenol)propionate antioxidant.

The specific combination of antioxidants disclosed by Wegmann is shown to provide increased thermal stability from the comparative examples disclosed (page 23, lines 6-10).

Reyes-Gavilan discloses the combination of a hindered phenolic antioxidant and thioether antioxidant, where other hindered phenolic antioxidants than disclosed can be utilized. This combination is utilized to resist oxidation by increasing the thermal stability of the composition ([0003]). Wegmann utilizes the same combination, but with a specific hindered phenolic antioxidant, to also produce increased thermal oxidation of the lubricating composition. Since the combination of antioxidants disclosed by Wegmann is shown to produce beneficial results, it therefore would have been obvious for Reyes-Gavilan to also utilize the specific hindered phenolic antioxidant disclosed by Wegmann for the advantageous results.

18. Claims 9, 10, 19, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reyes-Gavilan (EP 1,054,052 A2) in view of Oysaed (US 2006/0122295 A1) and Wegmann (WO 2005/023886 A1).

Reyes-Gavilan, as discussed in paragraph 10 and incorporated here by reference, discloses a lubricating composition comprised of a hindered phenolic antioxidant and a thioether antioxidant.

The combination of Reyes-Gavilan and Oysaed, as discussed in paragraph 16 and incorporated here by reference, disclose a lubricating composition comprised of a hindered phenolic antioxidant and a thioether antioxidant, specifically ditridecyldithiopropionate.

The combination of Reyes-Gavilan and Wegmann, as discussed in paragraph 17 and incorporated here by reference, disclose a lubricating composition comprised of

a hindered phenolic antioxidant, specifically butyl-3-(3,5-di-tert-butyl-4-hydroxyphenyl)propionate and a thioether antioxidant.

Since the scope of Reyes-Gavilan is open to other forms that the specific hindered phenolic antioxidants and thioethers antioxidants disclosed, it would have been obvious to utilize the specific embodiments disclosed by Oysaed and Wegmann in the amounts disclosed by Reyes-Gavilan.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amy T. Lang whose telephone number is 571-272-9057. The examiner can normally be reached on M-F 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

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USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

ATZ  
8/16/06

*Vasu Jagannathan*  
VASU JAGANNATHAN  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1700